

REMARKS

These Remarks are in reply to the Office Action mailed 5 June 2007. No fee is due for the addition of any new claims. The fee for an appropriate Extension of Time to Respond is submitted herewith.

Claims 2-98 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 2-98. The present Response makes no changes to the claims, leaving claims 2-98 for the Examiner's present consideration. Reconsideration of the rejections is requested.

I. REQUIREMENT FOR INFORMATION UNDER 37 C.F.R. §1.105

The Examiner has made a requirement under 37 CFR 1.105 for "a copy of any documents that would be relating to the alleged prior art invention by Intel Corporation and Compaq Computer Corporation as stated in the IDS" filed 1/11/2007. Applicants submit responsive documents herewith.

A. Compaq Computer Corporation

In response, Applicants are submitting herewith all the responsive documents known and readily available to Applicants relating to the alleged prior art invention by Compaq Computer Corporation. Pursuant to MPEP 704.14(d), these documents are listed on a PTO form SB/08 submitted herewith. Pursuant to MPEP 704.14(d), it is not required that this submission satisfy the fee or certification requirements of 37 CFR 1.97 and 1.98. The documents are as follows:

1. documents bearing Bates numbers OPTIAMD 021598-022967 (numbered at the lower right corner);
2. an Expert Witness report of Robert Colwell, signed May 16, 2006 and submitted by the Defendant in OPTi Inc. v. NVIDIA Corporation, Civil Action 2:04-CV-377 (TJW), United States District Court For The Eastern District Of Texas, with certain non-responsive information and confidential information of Intel Corporation redacted;
3. an Expert Witness report of Allan Jay Smith in Response to the Invalidity Expert Report of Robert Colwell, signed May 31, 2006 and submitted by the Plaintiff in OPTi Inc. v. NVIDIA Corporation, Civil Action 2:04-CV-

377 (TJW), United States District Court For The Eastern District Of Texas,
with certain non-responsive information and confidential information of
Intel Corporation redacted.

B. Intel Corporation

With regard to the requirement for documents that would be relating to the alleged prior art invention by Intel Corporation, Applicants state that any such documents are confidential to Intel, and are currently under a Court-ordered Protective Order. Applicants have asked Intel for relief from the Protective Order in order to submit these documents to the U.S.P.T.O., but so far Intel has not granted the necessary permission.

Applicants therefore state that responsive documents that would be relating to the alleged prior art invention by Intel Corporation are not readily available to Applicants for submission at this time. Pursuant to MPEP 704.12(b), this is a complete reply to the Requirement for Information.

II. ART REJECTION

The Examiner rejected claims 2-98 under 35 U.S.C §102(e) as being anticipated by Hayek et al. (US 5,630,094). Of claims 2-98, claims 2, 11, 14, 24, 27, 37, 42, 52, 57, 65, 68, 75, 77, 79, 81, 84, 87, 89, 91, 93, 95, 97 are independent.

The Examiner indicated that the two declarations under 37 CFR 1.131(b) to establish a date of invention prior to the filing date of Hayek, filed in parent application 08/851,666, need to be re-submitted and directed to the particular claims in the present application.

In response, Applicants are submitting herewith a Second Declaration Of inventor Subir Ghosh Under 37 C.F.R. 1.131(b). The second inventor H.T. Tung appears to be unavailable to sign a similar declaration. Applicants therefore are submitting herewith a Petition Under 37 CFR 1.183 Requesting Waiver Of Signature Of Unavailable Inventor H.T. Tung For Second Declaration Under 37 CFR 1.131(b).

The Second Declaration Of Subir Ghosh Under 37 C.F.R. 1.131(b) provides documentary evidence that an embodiment of the invention of the subject patent application had been conceived at least as early as August 23, 1994, and diligently reduced to practice in the United States prior to January 1995, the filing date of the Hayek patent. It can be seen that all of the

elements of each of the pending independent claims were present in the device and shown to have been operational prior to January 1995.

Accordingly, Hayek is not prior art and cannot, either by itself or in combination with any other reference, preclude patentability of any of the independent claims 2, 11, 14, 24, 27, 37, 42, 52, 57, 65, 68, 75, 77, 79, 81, 84, 87, 89, 91, 93, 95 and 97.

Claims 3-10, 12-13, 15-23, 25-26, 28-36, 38-41, 43-51, 53-56, 58-64, 66-67, 69-74, 76, 78, 80, 82-83, 85-86, 88, 90, 92, 94, 96 and 98 all depend ultimately from one of the independent claims. These claims add their own limitations which, it is submitted, render them patentable in their own right. In any event, however, these claims should be patentable by reason of their dependency from allowable independent claims.

All the pending claims 2-98 should therefore be patentable over Hayek.

III. CONCLUSION

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including 5 December 2007.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 50 0869 (OPTI 3140-6) for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 5 December 2007

E-Sig: /warren s. wolfeld/
Warren S. Wolfeld, Reg. No. 31,454

HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
Half Moon Bay, CA 94019
(650) 712 0340 phone